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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,495	04/17/2001	Katsumi Okouchi	01081	5421

7590 07/10/2003
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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/10/2003 *11*

Please find below and/or attached an Office communication concerning this application or proceeding.

7.K

Office Action Summary

Application No.

09/835,495

Applicant(s)

OKOUCHI, KATSUMI

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) 27-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 16,20-22 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 April 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to applicant's amendment filed 4/28/03, wherein claims 1, 4, 5, 20, and 21 were amended; and claims 27-29 were added.

Election/Restrictions

2. Applicant's attempt to reinstate the method claims 23-25 as 27-29 is acknowledge; however, it should be noted that the withdrawal of the restriction requirement was in regard to claims 1-22 because applicant had canceled claims 23-25. The restriction is not withdrawn with respect to the method claims. Therefore, the newly submitted claims 27-29 are directed to an invention that is independent or distinct from the originally elected invention for the following reasons given in paragraphs 3 and 13 of paper number 6.

Since applicant has received an action on the merits for the originally elected invention, claims 27-29 are withdrawn from consideration as being directed to a non-elected invention.

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 4/28/03 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the motor and fan.

It should be noted that the addition of the motor to the drawings could be allowed based on the fact that this conventional and one of ordinary skill would readily recognize

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the placement of the motor relative to the housing and blade. However, the use of a fan is not necessarily conventional. Moreover, this is not support in the specification as to, for example, 1) how the fan would be orientated relative to other elements; 2) the shaped and size of the fan; 3) the location fan relative to other elements.

Specification

4. The amendment filed 4/28/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the addition of the reference characters "41" and "42" and the deletion of the phrase "(not shown)" in paragraphs [0038] and [0039]. Moreover, the addition in paragraph [0048] of the cover 11b appears to be new matter as well because it is not clear how the element referenced by 11b in Figure 2 is a cover. There does not appear to be any cover.

Applicant is required to cancel the new matter in the reply to this Office Action.

5. The disclosure is objected to because of the following informalities: The application serial number, 09/628,829, on page 14 appears to be incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 8-9 and 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 8-9 and 17-22 are being rejected under 35 U.S.C. 112, first paragraph, as claiming new matter. In this case, the drawing and amendments, filed 4/18/03 introduces new matter; specifically the deletion of the phrase "(not shown)" and the addition of the reference characters "41" and "42" on paragraphs [0038] and [0039] as well as the proposed new drawing adding the motor and fan outline.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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9. Claims 1-7, and 10 are rejected under 35 U.S.C. 102(a) as being anticipated by Foreign Document 11-170,203, hereinafter, FD '203.

FD '203 discloses the same invention as claimed including: a saw blade (4); a blade case (1/1a); and a light (3) disposed within the blade case laterally from a face of the saw blade and mounted to an inner wall of the blade case (see Figures 1 and 2) that opposes the saw blade in a lateral direction.

As to claim 3, the blade case of FD '203 includes a side portion that laterally opposed the saw blade and the mounting device is disposed within the side portion.

As to claim 4, the mounting device of FD '203 includes a cover (see Figure 2) that substantially protects the light from the saw blade, wherein a gap is provided.

As to claim 5, the light from the device of FD '203 is substantially parallel.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-2, 8, 9, 10-12, 13, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vavrik, U.S. Patent 2,488,947.

Vavrik discloses the invention substantially as claimed, as set forth in paragraph 9 of paper number 9, including a laterally located light that is mounted in a blade case; however, Vavrik is silent as to the specific location of the mounted light and therefore lacks the light mounted to a inner wall of the blade case that opposes the saw blade in a

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lateral direction. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to relocate the light of Vavrik on the inner wall (e.g., 9a) of the blade case that opposes the saw blade, as shown in Figures 3, 4 and 6, in a lateral direction in order to ensure proper lightening of the workpiece and blade during a cutting operation, because it has been held that rearranging parts of an invention involves only routine skill in the art.

As to claims 2 and 19, the modified device of Vavrik inherently discloses a mounting device because the light of Vavrik is mounted within the blade case.

As to claim 8, the modified device of Vavrik discloses a cooling device (8).

As to claim 9, the modified device of Vavrik discloses a motor (2) and at least one vent (58) capable of cooling the motor.

As to claims 10-12, the modified device of Vavrik discloses a portable circular saw with a base (12) and pivotally attached saw unit (1, see Figure 6).

As to claim 13, the modified device of Vavrik discloses a cutting tool with a base (12), handle (see Figure 2), and a power supply circuit that are capable of balancing the cutting tool.

As to claim 18, the modified device of Vavrik discloses a saw blade, blade case, motor, and a light as explained above and further including a power supply and coupling wherein the first circuit (e.g. the wires in the motor housing) and the second circuit portion (e.g. the terminals of the light bulb).

12. Claim 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vavrik, U.S. Patent 2,488,947.

The modified device of Vavrik discloses the invention substantially as claimed except for the power supply comprising a transformer located in the handle; however, the examiner takes official notice that it is old and well known in the art to use transformers in power supplies for the purpose of providing the specific amount voltage necessary to power the device (e.g. low volt lights). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a transformer with the device of modified device of Vavrik in order to use lower voltage lights with the device. As to the specific location of the transformer in the handle, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the transformer in the handle section of the device in order to balance the weight of the transformer with the sawing device, because it has been held that rearranging parts of an invention involves only routine skill in the art.

As to claim 15, the modified device of Vavrik lacks separate switches for the saw and light wherein they are positioned adjacent each other. However, at the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use separate switches for the blade and light in order to allow the light to help align the blade without the blade being activated because applicant has not disclosed that separate switches provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, would have expected applicant's invention to perform equally well with two switches because

both one and two switch devices perform the same function of allowing the saw and light to be powered. Therefore, it would have been obvious matter of design choice to modify the modified device of Vavrik to obtain the invention as specified in claim 15.

Allowable Subject Matter

13. Claims 16, 20-22 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

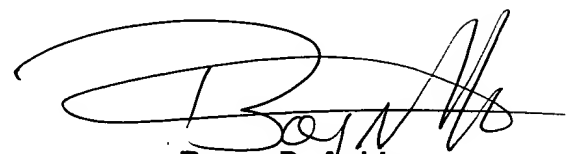
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday thru Thursday between 7:30am and 6:00pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.



Boyer D. Ashley
Primary Examiner
Art Unit 3724

bda
July 1, 2003